

REMARKS

Upon entry of the present paper the Claims under consideration are 1-16 and 25-26. Claims 17-24 are withdrawn in response to a restriction requirement. Applicants affirm the election of Group I as listed in paragraph 4 of the Detailed Action of 08 October 2003. Applicants have amended Claims 1, 2 and 16 to avoid formal objection thereto, to remove potentially confusing verbiage, and to make even more clear to the public that the thermoplastic elastomeric fiber strands have a surface comprising an adhesive. Applicants have amended Claim 26 to overcome the objection thereto. Claims 3-15 and 25 remain as originally filed. The Detailed Action will now be addressed with reference to the headings and any paragraph numbers therein.

Election/Restrictions

The Detailed Action has separated the Claims into Group I, Claims 1-16 and 25-26 (product made) and Group II, Claims 17-24 (process of making). The distinctiveness test of MPEP § 806.05 has been applied to assert distinctiveness of the Claim Groups. Applicants respectfully traverse the Restriction Requirement. The Detailed Action has stated only that the product as claimed can be made specifically with a neckable nonwoven web, i.e., a starting material which is not excluded by the language of the independent Claims of either Group. Thus neither part of the distinctiveness test of MPEP § 806.05 has been satisfied. It is therefore respectfully requested that the present Restriction Requirement be withdrawn.

Claim Objections

Per paragraph 6 of the Detailed Action, Claim 26 stands objected to as dependent upon a non-elected Claim. Claim 26 has been placed in independent form to obviate the rejection.

Claim Rejections -35 USC §102

Per paragraph 8 of the Detailed Action, Claims 1-11, 13-16 and 25 stand as anticipated by Quantrille *et al.* (U.S. Patent 5,804,286, hereinafter Quantrille). Applicants respectfully traverse these rejections and request reconsideration based on the following remarks.

Applicants respectfully point to limitations c) and d) of each of independent Claims 1, 2 and 16, wherein it is required that a laminate of the present invention have:

c) a plurality of thermoplastic elastomeric fibers (or “fiber strands” as in Claim 1) located between the first facing web and the second facing web; and

d) the fibers (or “fiber strands” as in Claim 1) having an elastic core and adhesive surfaces and bonding the first facing web and the second facing web together by contact adhesion with the adhesive surfaces of the fibers to create the elastic laminate.

Quantrille does not teach that its elastic fibers or fiber strands have adhesive surfaces. On the contrary, Quantrille teaches that adhesive, if used, will be separately applied between any layers of its laminates. See Quantrille at col. 9, lines 10-22.

The context of the present invention makes clear that what is being claimed is elastomeric fibers with inherently tacky surfaces, not elastomeric fibers which are placed as a layer in Quantrille and then have an adhesive later applied.

For example, at page 3, line 17 of the specification:

The facing webs, with the elastomeric fiber strands between them, are calendered together, thus adhering the facing webs together via contact adhesion with the elastomeric fibers. Thus no extra material, machinery, or steps for separate placement of adhesives is required.

And at page 4, line 1 of the specification:

Without excessive adhesive, the laminates are lighter, and more flexible while still retaining excellent bond strength between the layers and desired aesthetics. Further, because the strand construction may allow the facings to remain free between the strands, additional bulk and softness may be obtained with the present invention while still providing adequate strand-to-facing and facing-to-facing adhesion. Heretofore, no one is believed to have taught such an elastic laminate using tacky, or adhesive, elastomeric strands, because the person having ordinary skill in the art would likely consider such adhesive strands to be too difficult to work with in a practical manufacturing setting.

As is clear from the above, Quantrille does not anticipate the present invention. Applicants therefore respectfully request that the present rejections be withdrawn.

Specifically with respect to certain statements of the Detailed Action, Applicants comment as follows:

In paragraph 8 of the Detailed Action, at page 4, line 4, the present invention is characterized as “bonded with or without adhesive as per the instant claim 1...” Applicants respectfully submit that this statement of the Detailed Action evidences

a fundamental misunderstanding of the present invention, which requires in each Claim that first and second webs be held together by contact adhesion with the adhesive surfaces of elastic fibers to create the elastic laminate. Applicants therefore respectfully request that if the present rejections are maintained, the Office issue a second non-final Office Action clarifying this statement in order that Applicants be given the right to fairly respond.

In paragraph 8 of the Detailed Action, at page 4, line 14, the Detailed Action, in an apparent (but unstated) reference to Claim 8, states that: "The reference also discloses that cross-linked elastomers can be used as the fibers and that the multipolymer fibers may be bicomponent with a sheath/core structure (see column 7, line 63-column 8, lines 9)." Applicants first note that the multipolymer fibers of Quantrille are taught as being part of the extensible nonelastic web component of its laminate (see col. 3, line 55) and thus are not analogous to the presently claimed thermoplastic elastomeric fibers having elastic core and adhesive surfaces. Applicants also note that the cited passage of the reference in the above-quoted sentence does not discuss elastomers, whether cross-linked or not. Applicants therefore respectfully submit that this statement of the Detailed Action evidences a fundamental misunderstanding of the present invention. Applicants therefore must again respectfully request that if the present rejections are maintained, the Office issue a second non-final Office Action clarifying the intent and the basis of this rejection in order that Applicants be given the right to fairly respond.

In paragraph 8 of the Detailed Action, at page 4, line 17, the Detailed Action, in reference to Claims 3, 5, and 8-9, states that: "The reference discloses that the fibers can have a number of configurations for the sheath/core structure wherein the elastomers cross-linked with adhesives (sic) such as urethanes and rubbers as per instant claims 3, 5 and 8-9 (see column 8, lines 1-68)." Applicants respectfully note that Quantrille's discussion of col. 8 with respect to the various bicomponent configurations of the fibers, as at lines 1-7, is in the context of extensible, and not elastic, web filaments. Column 8 of Quantrille then discusses elastic fibers beginning at line 37, apart from the previous discussion of bicomponent fibers. It is thus clear that the Detailed Action has impermissibly used the present claims as a template to pick and choose among the teachings of the prior art in an attempt to reconstruct the present invention.

In paragraph 8 of the Detailed Action, at page 4, line 21, the Detailed Action, in reference to Claim 7, states that: "Column 9, lines 23-30 of the reference discloses that the adhesive can be a hydrocarbon as per instant claim 7." Applicants respectfully point out that Claim 7 requires that the adhesive, or more properly the tackifier, is required to make up the surface of the thermoplastic elastomeric fibers as per Claim 2. As noted above, the cited passage of Quantrille teaches only later and separately applied adhesives and not the adhesives as a part of the fibers per the teachings of the present invention. It is thus again clear that hindsight has been impermissibly used in the present rejection. Thus it is respectfully submitted that a *prima facie* case has not been made for any of the sec. 102 rejections, and all such rejections must be withdrawn.

Claim Rejections -35 USC §103

Per paragraph 10 of the Detailed Action, Claims 2 and 12 stand as obvious over Quantrille in view of Morman *et al.* (U.S. Patent 5,883,028, hereinafter Morman).

Per the above discussion, Quantrille does not suggest use of thermoplastic elastomeric fibers with surfaces comprising an adhesive component, as required by the Claims of the present invention. Morman, which derives the elasticity of its laminate from a breathable elastic film (unlike the elastomeric fibers of the claims), also lacks any teaching of thermoplastic elastomeric fibers with surfaces comprising an adhesive used to secure a laminate as per the present invention. Therefore neither of the cited references, either singly or in combination, fairly suggests the claims of the present invention, which are limited to the adhesive elastic fibers comprising adhesive surfaces such as taught by the present invention.

Specifically, with respect to the statement of the Detailed Action at the 10th line of paragraph 10, namely: “The reference [Quantrille] also discloses that the first layer contains multipolymer fibers with a plurality of bonds bonding the fibers together as per instant claim 1 (see column 2, lines 44-51).” Applicants object to the basis of this statement since Claim 1 does not specifically recite “a plurality of bonds” but only requires that the first and second webs be bonded together by contact adhesion with the recited adhesive fibers. Further, the “plurality of bonds” referred to in the cited passage of Quantrille are interfiber bonds creating its coherent extensible nonwoven web and do not refer to bonds between two different webs. Applicants therefore respectfully submit that this statement of the Detailed Action evidences a fundamental misunderstanding of the

present invention. Applicants therefore request that the rejections be reconsidered and withdrawn. In the alternative, Applicants must again respectfully request that if the present rejections are maintained, the Office issue a second non-final Office Action clarifying the intent and the basis of this rejection in order that Applicants be given the right to fairly respond.

For all the foregoing reasons, all Claims under consideration are believed to be allowable over the art of record. A notice to that effect is earnestly solicited.

The Examiner is invited to call Applicant's undersigned attorney should the Examiner feel that any issues remain after entry of the present amendment.

As Claim 26 has been amended to independent form, a check for \$86.00 is included herewith to cover the fee under 37 CFR § 1.16(b).

Favorable consideration is requested.

Respectfully submitted,



Roland W. Norris
Registration No. 32,799

Pauley Petersen & Erickson
2800 West Higgins Road; Suite 365
Hoffman Estates, Illinois 60195
TEL (847) 490-1400
FAX (847) 490-1403
rnorris@ppelaw.com